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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



re Application of: Vulpitta, et al.

Serial No.: 09/711,478

Group Art Unit: 1772

Filed: November 13, 2000

Examiner: Jane J. Rhee

For: ANTI-TELESCOPING ADHESIVE TAPE PRODUCT

Attorney Docket No.: MAEE 2 12957

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL OF BRIEF OF APPELLANT

Dear Sir:

In connection with the above-entitled case, please apply the enclosed remittance in payment of Patent and Trademark Office fees in the amount and for the purpose below indicated:

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Respectfully submitted,

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I hereby certify that this **TRANSMITTAL OF BRIEF OF APPELLANT** is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Board of Patent Appeals and Interferences, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on May 21, 2004.

By: Elaine M. Checovich
Elaine M. Checovich



PATENT

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Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Alexandria, Virginia 22313-1450

APPEAL BRIEF

Dear Sir:

This is an appeal from the decision of the examiner dated January 16, 2004 finally rejecting claims 1-10 in the above-captioned patent application. No claims are allowed.

1. Real Party in Interest

Henkel Kommanditgesellschaft auf Aktien of Duesseldorf, Germany is the real party in interest as assignee of the two named inventors.

2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of the Claims

The application contains claims 1-10 all of which stand rejected. The claims on appeal are claims 1-10. A copy of these claims appears in the Appendix of Claims on Appeal attached hereto.

4. Status of Amendments

All amendments have been entered.

5. Summary of the Invention and References

A. The Invention

The invention concerns improved adhesive tape products. The adhesive tape products involved are household and stationery products such as transparent and adhesive tape familiar to most consumers and office workers (specification page 1, lines 6-17). The adhesive tape product is often a long (300 inches) narrow ($\frac{1}{2}$ to 3 inches) tape wound upon a core. (Specification page 1, lines 10-15).

The problem being addressed by the invention is "telescoping". A telescoped roll of tape has succeeding layers slightly offset from one another creating a conical shape for the roll. Adhesive edges of each layer are exposed. The tape roll may not operate properly on a dispenser. (Specification page 1, line 15 to page 2, line 3). Telescoping is more of a problem with narrow tapes wound on small diameter cores (specification page 2, lines 4-6).

Applicants address the telescoping problem in three ways. In the embodiment of Figures 1-5 applicants divide the tape into three sections, a leader portion 24, a foam support portion 26 and a usable tape portion 30. a strip of compressible foam (14) is adhered to the foam support portion. The tape is wound around the core 12 with the leader portion fixing the tape to the core.

The foam strip and the foam support portion surrounds the core and are in turn surrounded by the usable tape portion. This structure is recited in claim 1 which also requires that the foam strip surrounds the core and that the tape surrounds the core and the foam strip. Claims 2-6 define additional structural details of the foam strip and core.

In the embodiment of Figures 6 and 8, a tape core (52) is provided with an outer surface (56) which bulges outwardly at its axial center (58) giving the core a barrel shape (see Figure 6). The tape (74) is wrapped about the barrel shaped core. (Specification page 6, lines 15-27). The barrel shaped tape core surrounded by adhesive tape in several layers is recited in claim 7.

Claim 6 depends on claim 1 and requires both a foam strip and a barrel shaped core.

Claims 8-10 depend on claim 7 and require both a foam strip and a barrel shaped core.

B. The References Used To Reject Claims

Schonhorn, et al. 0 430 548 A1 (European Patent) describes a collapsible hollow cylindrical core for adhesive tape rolls. One embodiment provides an axial gap in the core. A second embodiment (Figure 5) adheres a foam layer to the outer surface of a tape core. Schonhorn does not show a tape divided into three sections. Rather, Schonhorn describes a foam layer (a cylindrical sleeve) secured to the core by adhesive (col. 5, lines 1-6). Tape is apparently fixed to the foam layer.

Martin-Cocher, et al. 5,884,857 describes a method of making a stretched film used in packaging products for shipment. Martin-Cocher also describes the film and a spool assembly for short term storage of the film. As seen in the Figures, the film is wide and used in wrapping pallets of goods and the like. The film is pre-stretched different amounts in different zones across its width. The stretched film is stored on a reel to relax and stabilize before use (col. 3,

lines 55-65). Because the film has been stretched different amounts in different zones, it has different lengths across its width. This is accommodated by storing the film on a spool having a varying diameter. The spool is narrow for zones of low stretch (short length). The spool is thick for zones of high stretch (long length). The profile of the storage spool is similar to the roller used to stretch the film (col. 3, lines 55-65).

Martin-Cocher is not creating or supporting a tape product. Rather, Martin-Cocher is processing a very wide film in preparation for an industrial wrapping process. Martin-Cocher is not concerned with adhesive tape products; long, narrow adhesive tapes wound on a core, or, telescoping problems.

6. Issues

- A. Claims 1-5 and 6-10 are not obvious over Schonhorn.
- B. Claims 6-10 are not obvious over Schonhorn in view of Martin-Cocher, et al.
- C. There is no teaching to combine Schonhorn and Martin-Cocher.
- D. Martin-Cocher, et al. is not a proper reference for rejection of claims as it is not analogous.

7. Grouping of Claims

Claims 1 through 5 stand together reciting a tape core surrounded by a tape having a leader portion, a foam support portion and a usable tape portion, with a foam strip supported on the foam support portion and the tape surrounding the core.

Claim 7 stands alone reciting a barrel shaped tape core surrounded by tape.

Claims 6, 8-10 stand together reciting both a barrel shaped core and a foam layer.

8. Argument

A. Claims 1-5 and 6-10 are not obvious in view of Schonhorn

Claim 1 recites a hollow cylindrical core and a length of adhesive tape wound upon that core. The length of tape must comprise a leader portion fixed to the core, a foam support portion and a usable tape portion. The claim also requires a compressible foam strip fixed to the tape foam support portion. Schonhorn does not teach these structures. Rather, Schonhorn teaches a modified tape core. In Schonhorn's first embodiment, the core is slit axially. This provides a gap extending from one edge to the other. In this way, the core is collapsible. The body of tape is then wound upon this collapsible core. In the second embodiment, the one relied upon in the Office Action, the collapsible core is achieved by enveloping the outer surface of the core with foam. A foam sleeve is glued to the core. The Schonhorn structure requires one to apply adhesive either to the outside surface of the core or the inside surface of the foam sleeve, apply the foam sleeve to the core and then apply the tape to the foam sleeve.

Applicants' structure is different. Applicants do not make the core collapsible. Applicants do not mount a sleeve of foam material on a core and then wrap a length of tape around the foam material. Rather, applicants add a layer of compressible foam to the tape which is then wound around the core. This uses the adhesive already on the tape to bind the foam in place. Applicants do not need to separately adhere the foam to the core. Applicants use a simple strip of foam rather than a sleeve. Thus, claim 1 requires a length of tape to form a leader which is attached to the core. Schonhorn has no leader. Claim 1 also requires a foam support portion to which foam is attached which is then wound around the core. Schonhorn adheres the foam to

the core and thus has no tape foam support portion. The claim then requires that the tape continue to a usable tape portion wound around the core and foam completing the product.

The Final Office Action under appeal acknowledges that Schonhorn fails to disclose a tape divided into a leader portion, a foam support portion and a usable tape portion. The Office Action asserts that Schonhorn teaches that the adhesive on the core serves the equivalent function as the leader portion and the foam support portion. Applicants respectfully disagree. The passage in Schonhorn pointed to in the Office Action (column 5, lines 4-6) merely recites that the foam body may be secured to the core by means of adhesive. This teaches nothing concerning the use of a tape to secure the tape and a foam strip (not adhered to the core) in place upon the core. In applicants' invention, the foam strip is not adhered to the core. Rather, it is adhered to the portion of tape which it contacts. Thus, the Schonhorn passage does not teach applicants' claimed structure or the function of the claimed structure, adhering the tape directly to the core with the tape holding the foam strip. If one asserts that achieving the same broad overall result in a prior art reference structure, (creating an adhesive tape product on a core) is enough to support obviousness of specific structures, very few things are patentable. A new electric switch would not be patentable under the reasoning of the Office Action. It functions to turn lights on and off, just like existing switches. This would be so regardless of electrical or mechanical innovations in the new switch. Clearly, this is not the law.

It appears that the rejection may be based upon a reading of Applicants' specification and use of these teachings to say that Schonhorn teaches structures which are equivalent. Such a basis of rejection is improper under *In re Ruff*, 256 F.2d 590, 596, 118 USPQ 340, 346 (CCPA 1958). One may not use the teachings of an application to establish equivalency of structures in

a particular application. The equivalency of structures in addressing a particular problem must come from the prior art, not the application being examined.

The Office Action next points to the passage in Schonhorn starting at column 4, line 56 and finishing in column 5, line 1. That passage merely endorses the enveloping of the outer surface of a non-severed core with foam. It does not describe the advantages or the structure of using an adhesive tape leader to fix the tape to the core, using a length of the tape to support a foam strip and then wrapping the entire adhesive tape body around the core. As described above, this structure is achieved without the need to apply adhesive to the core or foam. A process step is saved. Nothing in the reference suggests this structure or that this structure would be equivalent to adhering the foam directly to the core.

The section of the Office Action asserting that Schonhorn teaches the equivalent structure to claim 1 closes with the assertion that Schonhorn teaches the equivalent function of Applicants' anti-telescoping adhesive product. Applicants are claiming a specific structure, not a function.

It is respectfully submitted that claim 1 and claims 2-6 depending from claim 1 are allowable over Schonhorn for the reasons stated above. Additionally, claims 6-10 all require a bulge in the outer surface of the tape core making it barrel shaped. Schonhorn does not teach such a structure. It is submitted that claims 6-10 are also allowable over Schonhorn.

B. Claims 6-10 are not obvious over Schonhorn in view of Martin-Cocher

The Office Action also continues the rejection of claims 6-10 as unpatentable over Schonhorn in view of Martin-Cocher, et al. This rejection is improper for several reasons. First, it is asserted and supported by factual analysis that there is no teaching in the prior art to combine Schonhorn and Martin-Cocher under heading C below. Second, it is asserted and

supported with resort to factual analysis and case law that Martin-Cocher is not analogous art under heading D below. Third, nothing in either reference or in the two references combined (which is improper), teaches an adhesive tape product using a core which bulges at its center line to address the telescoping problem. Schonhorn teaches cores which have a uniform cross section from one axial extreme to the other. Martin-Cocher teaches nothing concerning a tape core. Even if one looks at the spools in the Martin-Cocher, one is not presented with a teaching concerning the advantages of a barrel shape with respect to telescoping or anything else. Martin-Cocher describes numerous shapes for “pre-stretching” rollers in Figure 2-7 to stretch its wide film in different ways. Martin-Cocher then states that the short term storage spool should have a profile analogous to the roller (col. 3, lines 62-65). Thus, Martin Cochera teaches the usefulness of a spool having three bulges and two interior necked-down portions (Fig. 2); a spool having two axially spaced bulges (Fig. 5) and a spool having two recesses and a central bulge (Fig. 6). With reference to Figure 7, Martin-Cocher describes a modular approach to build any selected shape. Thus Martin-Cocher does not teach the advantage of a barrel shape for anything; it teaches differential stretching and shaping a spool to accommodate such stretching. Combining these references (which is improper) does not teach a tape core having a barrel shape to address telescoping or for any other reason. Only applicants teach this concept. Thus, claims 6-10 are allowable as they require this barrel shape. Moreover, nothing in either of the references teach the use of this barrel shaped core in combination with a layer of foam. Thus, claims 6 and 8-10 are allowable. The rejection should be reversed.

C. There is no teaching to combine Schonhorn and Martin-Cocher

Martin-Cocher does teach a spool which has at least one large diameter zone, small diameter zones and conical sections between them. This is one of many shapes described. However, this spool is for temporary (48 hours) storage of a wide, non-adhesive film used in an industrial wrapping operation.

The Office Action states (by incorporating paragraph 2 of paper 18) that while Schonhorn fails to disclose a barrel shaped core, "Martin-Cocher et al. teaches that the core has an outer surface bulging outwardly near the core's axial center giving the core a barrel shape (figure 1 number 23) for the purpose of accommodating the elongation of the film and increase film thickness in its margins (col. 4, lines 56-58)." (page 3 of paper 18). Schonhorn is not using a film having increased thickness in its margins. The Schonhorn tape appears to be of uniform thickness over its width. The Schonhorn tape is not stretched different amounts across its width. Thus, there is nothing in Schonhorn that teaches one to look to Martin-Cocher for what Martin-Cocher teaches.

Martin-Cocher teaches nothing concerning adhesive tapes and therefore does not lead one to Schonhorn.

In effect, the combination of references stated in the Office Action is being assembled to address the problem applicants are addressing through structures described by applicants. Only applicants teach that a barrel shape for a core will address telescoping. While Schonhorn is addressing telescoping, it does not recognize a barrel shaped core as a possible solution. There is nothing in either reference teaching use of a barrel shape to address telescoping. There is nothing in either reference suggesting the combination proposed.

The Final Office Action of January 16, 2004 addresses applicants' arguments concerning a lack of teaching to combine the references as follows. The action states that "Martin-Cocher teaches a barrel shaped core/spool wherein film is wrapped about a core." The word "core" does not appear in the Martin-Cocher patent. The use of the combination "core/spool" has no support and is an unfounded attempt to suggest that Martin-Cocher teaches equivalence between a "core" and a "spool". Martin-Cocher makes no such teaching. In the same paragraph, the action also states "Martin-Cocher teaches the general concept of a material wrapped around a core which is considered to be in the field of applicant's endeavor, therefore, it is appropriate to combine the two references since similar general concept of a material wrapped around a core is shared.". This does not establish a teaching in the prior art that will lead one to combine these two references to address the problem being addressed by applicants. In re Oetiker, 977 F.2d 1443, 24 USPQ2d (Fed. Cir. 1992), speaks to this situation. "There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."

There is no suggestion in either Martin-Cocher or in Schonhorn which would lead one to the other reference. Schonhorn does not consider changing the profile of a tape core to a barrel shape. Martin-Cocher doesn't teach anything concerning tape cores. It is respectfully submitted that nothing has been pointed to which would lead one to combine these two references as suggested. The combination of these two references is improper and the rejection based on the combination should be reversed.

D. Martin-Cocher Is Not Analogous

The Office Action dismisses applicants' assertion that Martin-Cocher is not analogous art stating that in order for art to be analogous it "must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned." The Action then asserts "In this case, Martin-Cocher teaches a barrel shaped core/spool wherein film is wrapped around the core/spool, applicant has an adhesive tape wrapped around a core. Martin-Cocher teaches the general concept of a material that is wrapped around a core, which is considered to be in the field of applicant's endeavor."

Claims 1 and 7 begin "An adhesive tape product". The title of the application is "ANTI-TELESCOPING ADHESIVE TAPE PRODUCT". Applicants' specification describes adhesive tape products and the telescoping problems associated with them. Thus, the field of applicants' endeavor is adhesive tape products with telescoping problems. Martin-Cocher is not concerned with an adhesive tape product. Rather, it is describing a non-adhesive product, a stretch film, to be used in industrial packaging applications such as pallet wrapping. The film is stretched different amounts in different zones across its width and is wide. Applicant is dealing with an adhesive coated tape which is from one half inch to three inches wide. Long narrow adhesive tape of the type typically used by consumers is not the same field of endeavor as industrial wrapping of pallets or products for shipment.

The other half of the test set forth in the Office Action is whether the reference is reasonably pertinent to the particular problem with which the applicants are concerned. Applicants are concerned with telescoping in rolls of adhesive tape. This is stated in the title of the invention and made clear throughout the specification. The reference makes no suggestion with respect to this problem and is not at all pertinent with respect to the problem as it is not

dealing with long narrow tapes wound upon a core. Martin-Cocher is not analogous art under the test set forth in the Office Action.

Numerous Federal Circuit cases support the distinction made above. In King Instrument Corp. v. Otari Corp., 767 F.2d 854, 226 USPQ 402 (Fed. Cir. 1985) cert. denied 475 U.S. 1016 (1986) it was held that a patent for splicing photo typographic film in the printing industry was not within the inventor's field of endeavor or pertinent to his problem with respect to a patent for splicing and winding magnetic tape into a cassette. While both were concerned with tapes, the problems encountered were very much different. The reference dealt with film that was 4 to 6 inches wide while the patent at issue concerned long narrow audio tape. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986) restated the two step test discussed above. Prior art is analogous only if the reference is "within the field of the inventor's endeavor" or is "reasonably pertinent to the particular problem with which the inventor was involved." Here, neither test is met.

The Office Action cites In re Oetiker, 977 F.2d 1443, 24 USQP2d 1443 (Fed. Cir. 1992) in support of the assertion that the field of applicants' endeavor is the wrapping of material around a core. It is respectfully submitted that wrapping of material is not the field of applicants' endeavor. It is not the problem applicants are addressing. The concept of finding a common broad thread in the references and calling it the field of applicants' endeavor is not supported by In re Oetiker. Rather, the opposite is supported.

In In re Oetiker applicant described and claimed a hose clamp. The applicant used a hook to maintain the preassembled condition of the hose clamp and the hook automatically disengaged when the clamp was tightened. Claims were rejected based upon an earlier Oetiker

patent on a hose clamp and Lauro '400 describing a plastic hook and eye fastener used in garments. Oetiker argued that there was no suggestion or motivation to combine the two references and also argued that Lauro was not analogous art. The Examiner and the Board of Appeals disagreed and maintained the rejection based on this combination. The Court of Appeals characterized the PTO position as follows:

The Examiner stated that "since garments commonly use hooks for securement", a person faced with a problem of unreliable maintenance of a pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The Examiner explained further by stating that "appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the Examiner's argument, or discuss its relevance. Indeed the argument is not supportable. However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it relates to a hooking problem, as does Oetiker's invention. (24 USPQ2d at 1445)

The Court of Appeals stated:

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facia* case of obviousness. (24 USPQ2d at 1446)

The Court of Appeals reversed the rejection and allowed the claims.

The Oetiker case is directly applicable here. Applicants' field of endeavor is consumer and stationery adhesive tape products. The problem the application is addressing is telescoping of such products. One can not, under the Oetiker holding, simply broaden out the field of the invention to include all things that are connected with a hook (as in Oetiker) or all things that are wrapped upon something (as here) to justify a rejection. For the reasons described in the Oetiker

case, it is submitted that Martin-Cocher is not analogous art. It is not a proper reference. The rejection of claims 6-10 based upon Martin-Cocher is improper and should be reversed.

Claims 6 requires the three portion tape and foam strip of claim one plus a barrel shaped core. The references, taken singly or together, do not teach this structure. Claims 8-10 require a barrel shaped core and a foam strip surrounding the core and surrounded by a length of adhesive tape. The references, taken singly or together, do not teach this structure. Additionally, claims 6 and 8-10 are allowable in view of the arguments set forth above with respect to claim 1 and with respect to claim 7. The rejection of these claims should be reversed.

E. Summary of Argument

Neither of the references teaches a tape having a leader portion, a foam support portion and a usable portion with a foam strip fixed to the foam support portion. Therefore, claims 1-6 are not properly rejected. Nothing in the references teaches using a barrel shaped core under several turns of adhesive tape to prevent telescoping in an adhesive tape product. Therefore, claims 6 and 7-10 are not properly rejected. Martin-Cocher is not a proper reference for use in rejecting claim 7 as it is non-analogous and Martin-Cocher is not properly combined with the primary reference, Schonhorn as there are no teachings (outside of applicants' specification) to combine these references. Claims 6-10 are not properly rejected.

It is respectfully submitted, that claims 1-10 are not obvious over Schonhorn and that claims 6-10 are not obvious over Schonhorn in view of Martin Cocher, et al. Accordingly, a reversal of the examiner's decision finally rejecting claims 1-10 and a finding of patentability with respect to these claims is in order and is respectfully requested.

Respectfully submitted,

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9. APPENDIX OF CLAIMS ON APPEAL

1. An adhesive tape product comprising:
 - a hollow cylindrical core having a diameter and a width and an outer surface;
 - a length of adhesive tape having a uniform width and a length substantially greater than said width wound in several turns about said core said length of tape comprising a leader portion
- 5 fixed to said core, a foam support portion and a usable tape portion; and,
 - a compressible foam strip fixed to said tape foam support portion.
2. The adhesive tape product of claim 1, wherein said foam strip is 40 mils (1 mm) thick.
3. The adhesive tape product of claim 1, wherein said foam strip surrounding said core has a total thickness of 40 mils (1 mm).
4. The adhesive tape product of claim 1, wherein said foam strip surrounds said core in a single layer and said foam strip is 40 mils (1 mm) thick.
5. The adhesive tape product of claim 1, wherein said core comprises a thin solid tubular wall.

6. The adhesive tape product of claim 5, wherein said core has an outer surface bulging outwardly near the core's axial center giving said core a barrel shape.

7. An adhesive tape product comprising:

a tape core having an axial width, said core being hollow with a solid outer wall, said outer wall having an outer surface which bulges outwardly at its axial center giving said core a barrel shape; and,

5 a length of adhesive tape having a uniform width and a length substantially greater than said width wound in several turns about said core.

8. The adhesive tape product of claim 7, additionally comprising a compressible foam strip surrounding said core and surrounded by said length of adhesive tape.

9. The adhesive tape product of claim 8, wherein said foam strip is 40 mils (1 mm) thick.

10. The adhesive tape product of claim 9, wherein said foam strip has a width approximately equal to said adhesive tape width and surrounds said core in a single layer.